

Notice of Allowability

Application No.

09/690,773

Examiner

Tadesse Hailu

Applicant(s)

RHOADS ET AL.

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment entered on August 8, 2005.
2. ☒ The allowed claim(s) is/are 3-5, 7-9 and 12-15.
3. ☒ The drawings filed on 17 October 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 8/8/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. This Office Action is in response to the Amendment entered on August 8, 2005 for the patent application number 09/690,773.
2. The pending claims 3-5, 7-9, 12-15, and 17-23 are examined herein as follows.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3-5, 7-9, and 12-15, drawn to a system, method and computer readable medium for enabling a user to associate a machine behavior with an object, including a registration system and database system, classified in class 715, subclass 768, class 705, subclass 50, and class 380, subclasses 202, and 255.
 - II. Claims 17-23, drawn to a watermark enabled object associated with a machine behavior via a watermark embedded in an object, where the object is a sticker, prop, and facets; the machine behavior includes launching an email, launching Internet chat session and placing a telephone call classified in class 713, subclasses 150, 193.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Inventions Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each Group I-II has separate utility such as " a registration system ..." and "a database management system ..." and "presenting a user interface ...", "receiving a specification ..." and "updating a database..." as in Group I; and "a watermark enabled object associated with a machine behavior, wherein the object is a sticker, prop, facets; and a machine behavior includes launching an email, launching an Internet and placing a telephone call to a destination.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Joel R. Meyer on August 18, 2005, affirmation of election was made to prosecute the invention of Group I, i.e., claims 3-5, 7-9, and 12-15; and the invention of Group II, i.e., Claims 17-23 are withdrawn and canceled, as being drawn to a non-elected invention.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Joel R. Meyer on August 18, 2005.

The application has been amended as follows: **In the claim:**

Please **cancel** claims 17 through 23.

Please cancel the limitation of claim 15 and **replace** with -- *A computer readable medium on which stores instructions for executing the method of claim 12.* --

Examiner's Statement of Reasons for Allowance

8. Claims 3-5, 7-9, and 12-15 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claims 3-5, While Houser describes embedding a security object using, for example an object linking and embedding (OLE) technology, but Houser's security object is not embedded by "altering signals that are to form part of the objects to embed the object identifiers in the signals in a machine readable form" as recited in claims 3 and 4. Houser also fails to disclose "a registration system" and "a database management system" as recited in claims 3-5.

Regarding claim 7, the claim calls for the object identifier (i.e., physical object) embedded into the object using a watermark, in contrast, Houser's security object is inserted in an electronic file (which is NOT a physical object) using object linking and embedding (OLE) technology. Houser also fails to teach "a registration system" and "a data management system" as recited in the claim.

Regarding claims 8-9, the Houser reference fails to teach a machine behavior, wherein the behavior is fetching a web page. Houser also fails to teach "a registration system" and "a data management system" as recited in the claims.

Regarding claims 12-15, the claims call at least for the registration identifier is embedded in a watermark on the object (physical object). But, Houser's security object is embedded into electronic file, not embedded in a physical object. The prior art of records further fails to describe at least the user interface is a web page based interface, and the user establishes a connection with the web based interface automatically in response to decoding the watermark on the object as recited in claim 14. Furthermore, Houser fails to teach, "updating a database" as recited claims 12-15.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

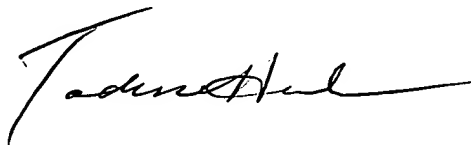
CONCLUSION

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

Art Unit: 2173

9. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu
Art Unit 2173
8/19/05

A handwritten signature in black ink, appearing to read "Tadesse Hailu", written in a cursive style.